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EXAMINER
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POWERS, WILLIAM S

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/022,559  
Filing Date: December 14, 2001  
Appellant(s): PETROGIANNIS ET AL.

\_\_\_\_\_  
Gregory A. Sebald, Reg. No. 33,280  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/19/2010 appealing from the Office action mailed 6/18/2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application: 1-14, 17-36, 38, 41-59 and 63-68.

**(4) Status of Amendments**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief. No amendments were filed after the Office Action of June 18, 2009.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The Examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

**(8) Evidence Relied Upon**

2001/0014839	Belanger et al.	11-1997
6,091,835	Smithies et al.	7-2000
7,209,571	Davis et al.	4-2007
6,085,322	Romney et al.	7-2000
5,649,186	Ferguson	7-1997
6,151,624	Teare et al.	11-2000
5,606,609	Houser et al.	2-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1, 2, 4, 5, 6, 8-12, 14, 17, 22-27, 29, 30, 32-36, 38, 41, 46-50, 52-55, 57-59, 63, 67 and 68 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0014839 to Belanger et al. (hereinafter Belanger) in view of US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 7,209,571 to Davis et al. (hereinafter Davis) in further view of US Patent No. 6,085,322 to Romney et al.

As to claims 1 and 25, Belanger teaches:

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- a. Having the user access the web environment through a web browser from a secure electronic system, said secure system having verified the identity of the user (the user has a password to logon to the server) (Belanger, [0034]).

The system of Belanger resides on the internet server and the user only needs a computing device with a web browser to use all of the functions of the system (Belanger, Abstract). Belanger further teaches applying digital signatures (Belanger, [0031]) and the creation and manipulation of electronic documents (Belanger, [0035]). Although Belanger teaches the editing of electronic documents residing on a server (Belanger, [0035]), applying a signature to a document is not expressly mentioned. However, in an analogous art, Smithies teaches:

- b. Having the user sign the electronic document in said web environment (the system of Belanger is entirely on the server side) (Belanger, Abstract), said signing comprising modules on the server performing (affirming electronic documents by attaching digital signatures to the electronic documents) (Smithies, column 12, lines 14-16 and column 41, line 39-column 42, line 52).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the server side system of Belanger with the electronic signing of electronic documents of Smithies in order to gather, create and store data related to a transaction event that can be reviewed at a later time, if necessary as suggested by Smithies (Smithies, col. 1, lines 15-35).

Belanger as modified further teaches the substeps of:

- i. Presenting the user with a web-based representation of the document in said web browser (accessing a document via a browser on the internet (web)) (Smithies, column 42, lines 8-24).
  - ii. Presenting the user with legal information related to said signing and getting agreement from the user of said legal information in said web browser (deliberation process must be executed by the signer) (Smithies, column 34, lines 8-17).
  - iii. Upon agreement of the legal information from the user, applying said signature of the user on said document on the server (after acknowledging the deliberation process, the user's signature is applied to the document) (Smithies, column 34, line 61-column 35, line 49).
- c. On the server, generating a process log (transcript object) of the signing of step b), said process log comprising a record of substeps b) i) to b) iii) as executed and allowing the reconstruction of the web-based representation of the document and of the legal information as presented to the user through said web browser (transcript object recreates the document and all actions during the signing procedure to the user for final approval of the signature and document) (Smithies, column 42, lines 32-52), and securely associating said process log with the document as signed (transcript object is associated with the affirmed document) (Smithies, column 8, lines 31-34 and column 14, lines 58-62).

- i. Generating a secure process authentication code  
(checksum, hash) uniquely representing said process log  
(transcript object) (Smithies, column 14, lines 22-39).

Belanger as modified teaches a link between the document and the transcript object (Smithies, column 14, lines 34-39 and 58-62), but does not expressly mention placing a hash in the signed document. However, in an analogous art Davis teaches:

- ii. Embedding said process authentication code (hash of metadata that is used to access metadata stored in a database) in said document as signed, thereby securely associating said process log and document (Davis, column 1, lines 55-64).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the web-based digital affirmation process of Belanger as modified with the embedding of a metadata hash in a digital object in order to authenticate data associated with digital objects as suggested by Davis (Davis, column 1, lines 16-18).

Belanger as modified does not expressly mention making the signed document available to the user. Although, it is implicit that the signed document would be available to the user for purposes of review, archiving and/or proof of purchase, in the case of a commercial transaction, as exemplified in the analogous art of Romney that teaches:

- d. Making the document as signed available to the user (client has copy of signed authenticated document) (Romney, column 11, lines 36-49).



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Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the web-based digital affirmation process of Belanger as modified with making the signed document available to the user in order for the user to have a copy of the signed document for his/her personal records.

As to claims 2 and 30, Belanger as modified teaches retrieving said document from a document storing location (Smithies, column 20, lines 55-63 and column 42, lines 8-30).

As to claims 4 and 32, Belanger as modified teaches transforming said document from a non-web format to a web-format (Smithies, column 20, line 55-column 21, line 7).

As to claims 5 and 26, Belanger as modified teaches said legal information comprises information about legal implications of the signing of the document (Smithies, column 34, lines 8-18).

As to claim 6 and 27, Belanger as modified teaches said legal information comprises legal disclosures related to said document (Smithies, column 13, lines 14-23 and column 22, lines 2-7).

As to claims 8 and 29, Belanger as modified teaches presenting said legal information in a series of dialog boxes (Smithies, column 34, lines 5-33 and figures 4a-g).

As to claims 9 and 33, Belanger as modified teaches associating user-specific information to said document (Smithies, column 12, lines 51-55 and column 33, lines 6-34).

As to claims 10 and 34, Belanger as modified teaches said user-specific information is included in a special signature file defining the signature of the user (Smithies, column 13, lines 42-46).

As to claims 11 and 35, Belanger as modified teaches comprises associating a digital certificate (transcript object) (Smithies, column 12, lines 32-38 and column 37, lines 25-33) and a private key to the document (Smithies, column 8, lines 38-44).

As to claims 12 and 36, Belanger as modified teaches obtaining said user-specific information from the secure electronic system (Smithies, column 33, lines 6-34 and column 12, lines 51-54).

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As to claims 14 and 38, Belanger as modified teaches storing said process log (transcript object) in a log database (Smithies, column 14, line 48-column 15, line 11).

As to claims 17, 41 and 63, Belanger as modified teaches providing an audit trail of the signing of step b) in the document as signed (Smithies, column 28, line 46-column 29, line 67).

As to claims 22 and 46, Belanger as modified teaches transmitting a copy of the document as signed to the user (Romney, column 11, lines 34-49).

As to claims 23 and 47, Belanger teaches enabling the user to download the document as signed (Romney, column 11, lines 34-49).

As to claims 24 and 48, Belanger teaches making the document as signed available to at least one additional party concerned by said electronic document (Romney, column 11, lines 34-49).

As to claim 49, Belanger teaches:

- a. Accessing means for accessing said web environment from a secure electronic system through a web browser (the user has a password to logon to the server through a browser) (Belanger, [0034]).

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- b. A document-rendering module on the server for presenting the user with a web-based representation of said document in said web browser (server side documents can be created and/or edited by the user through the browser) (Belanger, [0035]).

The system of Belanger resides on the internet server and the user only needs a computing device with a web browser to use all of the functions of the system (Belanger, Abstract). Belanger does not expressly mention the use of a legal disclosure module. However, in an analogous art, Smithies teaches:

- c. A legal disclosure module on the server for presenting the user, in said web browser, with legal information related to electronically signing said document and obtaining agreement from the user of said legal information document in said web browser (deliberation process must be executed by the signer) (Smithies, column 34, lines 8-17).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the server side system of Belanger with the legal information generator of Smithies in order to gather, create and store data related to a transaction event that can be reviewed at a later time, if necessary as suggested by Smithies (Smithies, col. 1, lines 15-35).

Belanger as modified further teaches:

- d. A document approval module on the server for providing the signature of the user to the document upon agreement from the user of the

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legal information, thereby signing said document (once a positive result is obtained, the signature is applied to the document) (Smithies, column 29, lines 46-53).

e. A process log module on said server for generating a process log of the signing of the document and securely associating said process log with the document as signed, said process log comprising reconstruction data for allowing the reconstruction of the presenting the user with said web-based representation of the document (transcript object recreates the document and all actions during the signing procedure to the user for final approval of the signature and document) (Smithies, column 42, lines 32-52).

f. Presenting the user with said web-based representation of the document (Smithies, column 42, lines 8-24).

g. Presenting the user with said legal information (Smithies, column 34, lines 8-17).

h. Generating a secure process authentication code (checksum, hash) uniquely representing said process log (transcript object) (Smithies, column 14, lines 22-39).

Belanger as modified teaches a link between the document and the transcript object (Smithies, column 14, lines 34-39 and 58-62), but does not expressly mention placing a hash in the signed document. However, in an analogous art Davis teaches:

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- i. Embedding said process authentication code (hash of metadata that is used to access metadata stored in a database) in said document as signed, thereby securely associating said process log and said document (Davis, column 1, lines 55-64).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the web-based digital affirmation process of Belanger as modified with the embedding of a metadata hash in a digital object in order to authenticate data associated with digital objects as suggested by Davis (Davis, column 1, lines 16-18).

- j. Obtaining agreement from the user of said legal information and of said signing of the document (Smithies, column 29, lines 46-53).

Belanger as modified does not expressly mention making the signed document available to the user. Although, it is implicit that the signed document would be available to the user for purposes of review, archiving and/or proof of purchase, in the case of a commercial transaction, as exemplified in the analogous art of Romney that teaches:

- k. A document distribution module for making the document as signed available to the user, wherein said accessing means and said document-rendering, legal disclosure, document approval, process log and document distribution modules are server-based (Romney, column 11, lines 34-49).

Therefore, one of ordinary skill in the art at the time the invention was made would have been motivated to implement the web-based digital affirmation process of

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Belanger as modified with making the signed document available to the user in order for the user to have a copy of the signed document for his/her personal records.

As to claim 50, Belanger as modified teaches said document-rendering module comprises retrieving means for retrieving said document from a document storing location (Smithies, column 20, lines 55-63 and column 42, lines 8-30).

As to claim 52, Belanger as modified teaches transforming means for transforming said document from a non-web format to a web-format (Smithies, column 20, line 55-column 21, line 7).

As to claim 53, Belanger as modified teaches said legal information comprises information about legal implications of the signing of the document (Smithies, column 34, lines 8-18).

As to claim 54, Belanger as modified teaches said legal information comprises legal disclosures related to said document (Smithies, column 13, lines 14-23 and column 22, lines 2-7).

As to claim 55, Belanger as modified teaches said legal disclosure module comprises displaying means for displaying (Smithies, column 19, lines 39-43) said legal information (Smithies, column 24, lines 63-67) in a web-based medium (Smithies, column 12, lines 14-16).

As to claim 57, Belanger as modified teaches said web-based medium includes a plurality of dialogue boxes (Smithies, column 34, lines 5-33 and figures 4a-g).

As to claim 58, Belanger as modified teaches:

- a. A user binding module cooperating with the secure electronic system to obtain therefrom user-specific information (Smithies, column 12, lines 51-55 and column 33, lines 6-34).
- b. Generating a special signature file using said user-specific information (Smithies, column 13, lines 42-46).
- c. Providing said special signature file to the document approval module, said special signature file defining the signature of the user (Smithies, column 13, lines 42-46).

As to claim 59, Belanger as modified teaches said user-specific information comprises a digital certificate (transcript object) (Smithies, column 12, lines 32-38 and column 37, lines 25-33) and private key (Smithies, column 8, lines 38-44).



As to claim 67, Belanger teaches transmitting a copy of the document as signed to the user (Romney, column 11, lines 34-49).

As to claim 68, Belanger teaches provides a copy of the document as signed to at least one additional party concerned by said electronic document (Romney, column 11, lines 34-49).

14. Claim 3 and claim 31 and claim 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0014839 to Belanger et al. (hereinafter Belanger) in view of US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 7,209,571 to Davis et al. (hereinafter Davis) in further view of US Patent No. 6,085,322 to Romney et al. (hereinafter Romney) as applied to claim 1 and claim 25 and claim 49 respectively above, and further in view of US Patent No. 5,649,186 to Ferguson.

As to claims 3 and 31, Belanger as modified does not expressly mention the use of templates in the generation of documents. However, in an analogous art, Ferguson teaches generating said document from a template (Ferguson, column 2, lines 52-60).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the web-based electronic signing scheme of Belanger as modified with the use of templates to generate documents of Ferguson

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in order to display them in a standardized way (HTML) as suggested by Ferguson (Ferguson, column 2, lines 52-60).

As to claim 51, Belanger as modified teaches a document customization module cooperating with the document-rendering module for generating said document from a template (Ferguson, column 2, lines 52-60).

15. Claim 7, claim 28 and claim 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0014839 to Belanger et al. (hereinafter Belanger) in view of US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 7,209,571 to Davis et al. (hereinafter Davis) in further view of US Patent No. 6,085,322 to Romney et al. (hereinafter Romney) as applied to claim 1 and claim 25 and claim 55 above, and further in view of US Patent No. 6,151,624 to Teare et al. (hereinafter Teare).

As to claims 7 and 28, Belanger as modified teaches displaying the legal information concerning the signing of a document (Smithies, column 34, lines 8-18), but does not expressly state that the legal information is displayed as a web page. However, in an analogous art, Teare teaches presenting said legal information in a series of web pages (Teare, column 16, lines 16-27).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the web-based electronic signing scheme of Belanger as modified with the presentation of the legal information associated with the signing as a web page of Teare so that the user can accept or decline the legal agreement over the internet as suggested by Teare (Teare, column 16, lines 16-27).

As to claim 56, Belanger as modified teaches said web-based medium includes a plurality of web pages (Teare, column 16, lines 16-27).

16. Claims 18-21 and claims 42-45 and claims 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Application Publication 2001/0014839 to Belanger et al. (hereinafter Belanger) in view of US Patent No. 6,091,835 to Smithies et al. (hereinafter Smithies) in view of US Patent No. 7,209,571 to Davis et al. (hereinafter Davis) in further view of US Patent No. 6,085,322 to Romney et al. (hereinafter Romney) as applied to claim 17 and claim 41 and claim 49 respectively above, and further in view of US Patent No. 5,606,609 to Houser et al. (hereinafter Houser).

As to claims 18, 42 and 64, Belanger as modified does not expressly mention hashing a signed document to use as an authentication measure. However, in an analogous art, Houser teaches including a secure document authentication code

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uniquely representing said document as signed in said audit trail (Houser, column 4, lines 20-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the web-based digital signature scheme of Belanger as modified with the hashing of a signed document of Houser in order to ensure the validity of a signed document as suggested by Houser (Houser, column 4, lines 27-34).

As to claims 19 and 43, Belanger as modified teaches storing said secure document authentication code in a database (Smithies, column 14, line 48-column 15, line 11).

As to claims 20, 44 and 65, Belanger as modified teaches generating a hash of said document as signed defining the secure document authentication code (Houser, column 4, lines 20-34).

As to claims 21, 45 and 66, Belanger as modified teaches embedding a secure document authentication code (hash of signed document) uniquely representing the document as signed inside said document (Houser, column 4, lines 20-34).

**(10) Response to Argument**

Appellants assert that, "The Office Action is silent as to Belanger presenting the user with a web based representation of the document in the browser and presenting the user with legal information related to the signing, getting agreement from the user of the legal information in the web browser and upon agreement of the legal information from the user, applying the signature of the user on the document on the server. In addition, Applicants assert that step c) is not shown or suggested by Belanger in the Office Action" (Appeal Brief, p. 12), the Examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellants assert that, "Applicants reiterate these arguments and assert that the arguments have not been fully considered and that no reason has been provided why the arguments are not persuasive. Moreover, the Action has not refuted the arguments raised in the Amendment of April 20, 2009" (Appeal Brief, p. 12), the Examiner respectfully disagrees. Applicants' arguments were fully considered in the Office Action of 6/18/2010. A new grounds of rejection was made in light of the amendments and arguments. The Belanger patent was brought in to explicitly teach the limitations of a

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web browser accessing a document on the Internet and displaying that document to user in the web browser (Belanger, Abstract and [0035]).

Appellants assert that, “the first substep b(i) of claim 1, includes presenting the user with a web-based representation of the document in the web browser. As explained in the specification, in practice this may be realized, for example, by a merchant e-commerce website performing a hand-off to the e-Signing Process (the server) and providing all necessary data and information to generate the appropriate contract for approval and signature. In the method recited in claim 1, the server therefore manages the signing ceremony and presents the document through a web browser to the user rather than the merchant or another system or application” (Appeal Brief, p. 13), the Examiner respectfully disagrees. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the server providing all necessary data and information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if the limitations were present in the claims as written, the Belanger reference teaches a server providing all necessary data and information as the system of Belanger resides on a server and interacts with users (Belanger, Abstract). As noted above, the Appellants' assertions are directed to an essentially piecemeal prosecution and looks to each individual reference for evidence of claim limitations rejected under

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35 USC § 103(a) and does not consider the combination of references used for the rejection.

Appellants assert that, "Although this passage refers to the presenting of information related to a legal issue, legal accountability to an affirming party, the passage does not teach or suggest that this should be done through a web browser" (Appeal Brief, p. 13), the Examiner respectfully disagrees. The Belanger reference is used to support the use of a web browser to access and manipulate documents on the Internet (Belanger, Abstract). Moreover, Smithies explicitly states that the electronic affirmation scheme can be applied to the Internet through the use of web browsers (Smithies, col. 41, line 39-col. 42, line 7). As noted above, the Appellants' assertions are directed to an essentially piecemeal prosecution and looks to each individual reference for evidence of claim limitations rejected under 35 USC § 103(a) and does not consider the combination of references used for the rejection.

Appellants assert that, "In a web embodiment of Smithies described in columns 41-42, the presenting and agreement of legal information is not discussed or mentioned. Applicants further note that in the web embodiment of Smithies, an interface program is installed on the user's computer system to interact with the affirming party. In addition, Smithies does not rely on the web pages presented to the user containing the form in order to interact with the user and create the signing ceremony" (Appeal Brief, pp. 13-14), the Examiner respectfully disagrees. Smithies states, "It is noted that the teachings of the present invention can be applied to a wide variety of applications where the affirmation of a document, transaction or event is necessary and for obtaining a good

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record of the identity and intent of the affirming party" (Smithies, col. 41, lines 41-45) and that the teachings can be applied to the Internet or similar networked computer systems (Smithies, col. 41, lines 52-53). Smithies does not state that some of the teachings can be applied to the Internet, but all the teachings can be applied to the Internet. In addition, the "interface program" as mentioned by the Appellants is seen as equivalent to a web browser and there is nothing in the claim language that prohibits the use of an interface program installed on the user's computer system. As noted above, the Appellants' assertions are directed to an essentially piecemeal prosecution and looks to each individual reference for evidence of claim limitations rejected under 35 USC § 103(a) and does not consider the combination of references used for the rejection.

Applicants assert that, "the cited passage does not discuss or mention in any way the actual application of the signature on the document. Moreover, the cited passage does not discuss or teach that the document resides on a server. The server-related aspect of claim 1 cannot be demonstrated by the embodiment of the passage cited in Smithies as actions do not take place over the web. Moreover, in the only web embodiment of Smithies, the document does not reside on the server performing the signing ceremony. In Smithies, the document is a web form presented to the affirming party by a different entity than the transcript generator module managing the ceremony. As the signature is never sent to that entity in Smithies, the signature cannot be applied to the document at all" (Appeal Brief, p. 14), the Examiner respectfully disagrees. It is noted that the references are considered in their entirety in regards to the rejection. The



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cited passages offer insight into the rejection, but should not be considered in a vacuum. The cited passage, Smithies, col. 34, line 61-col. 35, line 49, outlines the signature process. Smithies, col. 33, lines 6-47, offers more detail and insight into the signature scheme in which a signature is applied to a contract (document) (Smithies, col. 33, lines 27-34 and col. 24, lines 48-55) and that signifying approval of some or all of a document is analogous to "handwriting one's initials next to the item if it were printed on paper" (Smithies, col. 33, lines 44-47). As to the web environment, the server in Belanger hosts the entire document handling (Belanger, Abstract) and this is supported by Smithies in the Internet embodiments (Smithies, col. 41, line 21-col. 42, line 52) wherein the transcript generator module and the client application reside on the same server (Smithies, col. 41, line 64-col. 42, line 7). As noted above, the Appellants' assertions are directed to an essentially piecemeal prosecution and looks to each individual reference for evidence of claim limitations rejected under 35 USC § 103(a) and does not consider the combination of references used for the rejection.

Appellants assert that, "these interactions cannot include the web-based representation of the document being affirmed as presented to the user, since this document is never presented is never presented in the window in question. Moreover, Smithies does not consider having a same entity, the server, handle the presentation of the document to be affirmed, the steps of the signing ceremony, and the generation of the process log as Smithies promotes the segregation of these tasks among different components to prevent forgery" (Appeal Brief, p. 15), the Examiner respectfully disagrees. Details of the contents of the transcript object which is equated to the

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process log appear in Smithies, col. 12, line 49-col. 15, line 11). A one-way hash of the document is created as it is presented to the user for affirmation along with a time stamp to further bolster the record and to alert interested parties to any manipulation of the document after the affirmation operation has been executed (Smithies, col. 14, lines 5-21). As to the web environment, the server in Belanger hosts the entire document handling (Belanger, Abstract) and this is supported by Smithies in the Internet embodiments (Smithies, col. 41, line 21-col. 42, line 52) wherein the transcript generator module and the client application reside on the same server (Smithies, col. 41, line 64-col. 42, line 7). As to the segregation of components, the Examiner points to the MPEP 2144.04 V. B. that simply making separate components integral is given no patentable weight (*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)).

Appellants assert that, "in the method of claim 1 of the present application, the interaction with the user is recorded indirectly. Moreover, the present invention provides a simple and elegant manner of keeping a full record of the transaction with having to directly record every interaction of the affirming party with the system, as must be done with Smithies" (Appeal Brief, p. 16), the Examiner respectfully disagrees. The Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Appellant has merely stated that the process log is generated indirectly as opposed to directly; it is not part of the claim language. In either case, the transcript object of the prior art records all the interactions of the user with the document to be

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affirmed in order to create legally binding and enforceable affirmations (Smithies, col. 12, line 49-col. 15, line 11). As to the simplicity and elegance of the method, that is a subjective matter that bears no patentable weight.

Appellants assert that, "The approach of the present invention provides a significant advantage in a web environment as a server and any associated logic or programming presents requested web pages by creating them only as required for a particular user at a given moment. This does not store those particular pages as presented as a single record. Applicants assert that it would therefore be extremely difficult to reproduce the web pages presented to a user at a given time" (Appeal Brief, p. 17), the Examiner respectfully disagrees. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. The Belanger and Smithies references teach a sequential presentation of requested documents and related data (legal implications of signing...) as needed (Smithies, col. 42, lines 8-24 and col. 34, lines 8-17). The claim language clearly states that "generating a process log of the signing of step b) said process log comprising a record" (claim 1, c)). One record is created, not for each web page as asserted by the Appellant. As to the difficulty of reproducing web pages, the Appellant has offered no support for this subjective measure and is given no weight.

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully Submitted,

/William S. Powers/

William Powers

Examiner, Art Unit 2434

Conferees:

/Christian LaForgia/

Primary Examiner, Art Unit 2439

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434